

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of

David A. JACKSON, et al.

Serial No.: 09/840,924

Filed: April 25, 2001

For: MEASURING WHEEL BASE PARALLELISM WITH A POSITION
DETERMINATION SYSTEM

: Customer Number: 20277
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: Confirmation Number: 6504
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: Group Art Unit: 3661
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: Examiner: T. Nguyen
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RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Noting the Office Action of December 1, 2003 wherein restriction has been required, Applicants hereby elect Species II (claims 6, 8, 22 and 24) for continued prosecution in the above-identified application, with traverse.

In the Office Action issued on December 1, 2003, the Examiner applied a six-way restriction, in which it was characterized that the claims include the following distinctive species:

- Species I: Claims 4 and 20 (drawn to determining alignment by comparing the wheel tracks with reference values).
- Species II: Claims 6, 8, 22, 24 (drawn to determining alignment by comparing the wheel base with reference values).
- Species III: Claims 9-10, 25-26 (drawn to determining alignment by comparing the center point of a wheel track with a center line).
- Species IV: Claims 12, 28 (drawn to determining alignment based on comparing diagonals).
- Species V: Claims 13, 29 (drawn to determining alignment based on comparing each diagonal with a reference value).

Species VI: claims 14-16, 31-32 (drawn to determining alignment using skew angles).

In the Office Action, the Examiner did not provide any reason as to why the claims are distinctive.

Applicants traverse the restriction requirement on the ground that the restriction requirement is not proper. In order for the Examiner to appropriately require a restriction between claimed inventions, two criteria must be met: (1) the inventions must be independent or distinct as claimed (MPEP § 802.01, § 806.04, § 806.05-§ 806.05(i), § 808.01(a)); and (2) there must be a serious burden on the Examiner (MPEP § 803.02, § 806.04(a)-§ 806.04(i), § 808.01(a), and § 808.02). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions (MPEP § 803).

Applicants traverse the restriction requirement because none of the required criteria has been met. The Office Action failed to prove why the identified species are independent and distinct. Furthermore, there appears to be no significant burden on the Examiner to continue to examine the identified groups of claims. Notably, before the Restriction Requirement, the Examiner has already issued three office actions including two non-final office actions issued on July 30, 2002 and June 13, 2003, respectively, and a final office action issued on January 16, 2003. In other words, the Examiner has examined the subject claims three times. The majority of the pending claims either are already considered allowed/allowable by the Examiner, or remain unchanged since the second office action:

- (1) allowed claims: 9, 10, 12, 25 and 26;
- (2) allowable claims: 18 and 31;
- (3) claims remain unchanged since the second office action: 4, 6, 8, 15, 16, 20, 22, 24 and 32; and

- (4) claims with minor changes for formality reasons after the third office action: 13, 14 and 29.

By indicating claims are allowed or allowable, the Examiner considered that his search and examination relative to the claims are thorough and complete. Therefore, no further search is needed for allowed/allowable claims 9, 10, 12, 25, 18, 26 and 31.

For claims that remain unchanged since the second office action, the Examiner already completed his search when issuing the third office action on June 13, 2003. Thus, no further search is needed for claims 4, 6, 8, 15, 16, 20, 22, 24 and 32.

For claims 13, 14 and 29, they were slightly amended after the third office action for formality. Specifically, the claims are amended to indicate that the first and second diagonals are directed to the lengths of the diagonals. The amendment, however, does not affect claim scope, as it was clear from the specification that the term "diagonal" used in the claims is the length of the diagonal. As search relative to claims 13, 14 and 29 was already completed when the Examiner issued the third office action, there is no serious burden on the Examiner to continue to examine claims 13, 14 and 29.

Since the Examiner has not proved that the identified species are distinct or independent, and continued examination of the claims does not create serious burden on the Examiner if restriction is not applied, the restriction requirement is therefore improper. Withdrawal of the restriction requirement and continued examination of all the pending claims are respectfully requested.

Applicants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicants have inadvertently overlooked the need for a petition for extension of time. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in

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in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink that reads "Wei-Chen Chen". The signature is written in a cursive, flowing style.

Wei-Chen Chen

Recognized under 37 CFR §10.9(b)

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Date: December 31, 2003